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| 10/734,920 | 12/12/2003 | Michael Muller | IBM-001 | 2237 |
| 51835 7590 07/16/2008 IBM LOTUS & RATIONAL SW c/o GUERIN & RODRIGUEZ 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752 | | | | |
| EXAMINER | | | | |
| JOO, JOSHUA | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,920

Applicant(s)

MULLER ET AL.

Examiner

JOSHUA JOO

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/16/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 9 and 33-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 33-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. This Office action is in response to communication dated 04/16/2008.
Claims 1-6, 8-9, 33-41 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1-6, 8-9, 33-41 have been considered but are moot in view of the new ground(s) of rejection. New ground(s) of rejection are necessitated by Applicant's amendment.
a) Rejection of claims 23-25 under 35 U.S.C. 101 is withdrawn in view of Applicant's amendment.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the amended subject matter of claim 1 and added subject matter of claims 33-41 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, 8-9, 33-34, 38, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. US Publication #2004/0078448 (Malik hereinafter), in view of Request for Comments: 2822, P. Resnick, April 2001 (previously cited, Resnick hereinafter) and Kalfas, US Publication #2004/0199598 (Kalfas hereinafter).

7. As per claim 1, Malik teaches substantially the invention as claimed including a method of communicating with a user of a processor-based device over a network, the method comprising:

receiving by a first user an electronic mail message, the electronic mail message having a subject line, the subject line of the electronic mail message containing at least one text message (Paragraph 0092. Receive email message. fig. 10A. Subject line.);

receiving from the first user, while the first user has the electronic mail message selected, a command to initiate synchronous communications with a second user (Paragraphs 0092; 0095. User launches IM chat session from the email message.);

converting, in response to the command from the first user, the electronic mail message into a synchronous communications format that includes each text message contained in the subject line of the electronic mail message (Paragraph 0094. Include content of the subject as part of the IM chat session.); and

initiating, in response to the command from the first user, synchronous communications between the first and second users to present each text message contained in the subject line of the converted electronic mail message to the first and second users in the synchronous communications format (Paragraphs 0092; 0095. Initiate IM session with contact.).

8. Malik does not specifically teach that the electronic mail message is a body-less electronic mail message lacking a message body capable of receiving message content.

9. Resnick suggests of sending an electronic message that is lacking a message body capable of receiving message content (Abstract; sections 1.1; 2.1).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the electronic mail message as taught by Malik to be an electronic message lacking a message body capable of receiving message content. The motivation for the suggested

combination is that Resnick's teachings of lacking a message body would reduce the size of transmitted data and eliminate the need to open a message as suggested by Kalfas.

11. As per claim 2, Malik does not specifically teach the method of claim 1, wherein the subject line of the body-less electronic mail message includes one or more other text messages taken from a subject line of a previous body-less electronic mail message.

12. Resnick teaches of the subject line of an body-less message including one or more other text messages taken from a subject line of a previous body-less electronic mail message(Section 3.6.5. Subject field may start with "Re:" followed by subject of original message.).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the subject line of the electronic mail message as taught by Malik to include one or more other text messages taken from a subject line of a previous body-less electronic mail message as taught by Resnick. The motivation for the suggested combination is that Resnick's teachings would improve the suggested system by allowing a recipient to know whether the electronic mail is regarding a previously discussed topic.

14. As per claim 3, Malik, Resnick, and Kalfas taught the method of claim 1. Malik, Resnick, and Kalfas further teach the method of claim 1, wherein the subject line of the body-less electronic message includes one or more other text messages taken from a chat conversation converted into a format of a body-less electronic mail message (Paragraphs 0070; 0092. User can communicate by email or chat. It is inherent that the user may add content from a chat message to the subject of an email.).

15. As per claim 5, Malik, Resnick, and Kalfas taught the method of claim 1. Malik, Resnick, and Kalfas further teach the method of claim 1, further comprising receiving the body-less electronic mail

message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view having a column for the subject line, and displaying on the display screen a scroll bar arrow at one end of the subject line column, when a cursor is positioned over the subject column of the line item, for horizontally scrolling through the contents of the subject line (fig. 9. Window comprises a horizontal scroll bar at the end of the subject column for scrolling across the columns.).

16. As per claim 6, Malik teaches the method of claim 1, further comprising inserting a delimiter into the subject line to separate the text message from a previous text message currently included in the subject line (Paragraph 0086. Replay email. It is inherent that a user may insert a delimiter to separate the user's message from the previous subject.).

17. As per claim 8, Malik teaches the method of claim 1, further comprising converting a chat conversation into a body-less electronic mail message (Paragraphs 0070; 0092. User can communicate by email or chat. It is inherent that a user may copy and paste the contents of an IM message into the subject of the email message.).

18. As per claim 9, Malik, Resnick, and Kalfas taught of receiving the body-less electronic message. Malik, Resnick, and Kalfas further teach of the method of claim 1, further comprising displaying on a user interface a chat-like graphical window for engaging in synchronous chat in response to receiving the body-less electronic mail message over the network (fig. 10B; paragraph 0094. IM chat window.).

19. As per claim 33, Malik, Resnick, and Kalfas taught the method of claim 1 of receiving the body-less electronic mail message. Malik, Resnick, and Kalfas further teach the method comprising giving the

first user an option to reply to the received body-less electronic mail message with an electronic mail message having a body (Paragraph 0087. User may select email reply button.).

20. As per claim 34, Malik, Resnick, and Kalfas taught the method of claim 1. Malik further teaches the method comprising automatically generating a body-less electronic mail message when the first user chooses to reply to or forward the received body-less electronic mail message (Paragraph 0070; 0087. User may select email reply button. Compose new email. A new email would lack content in the body.).

21. As per claim 38, Malik does not explicitly teach the method of claim 1, further comprising presenting to a user an option to choose between generating a body-less electronic mail message and generating an electronic mail message with a message body.

22. Kalfas teaches of allowing a user to choose between generating a body-less electronic mail message and generating an electronic mail message with a message body (Paragraph 0034; 0037. User may create an email with complete message in subject, i.e. empty body.).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to allow a user to choose between generating a body-less electronic mail message and generating an electronic mail message with a message body. The motivation for the suggested combination is that Kalfas' teachings would improve the suggested system by allowing a complete message to be placed in the subject and thus eliminating the need for a recipient to open a message.

24. As per claim 40, Malik, Resnick, and Kalfas taught the method of claim 1. Malik, Resnick, and Kalfas further teach the method comprising: displaying the received body-less electronic mail message on a display screen as a line item in a mailbox view (fig. 9). Malik does not specifically teach of displaying

an indicator in association with the line item to identify the line item as a body-less electronic mail message.

25. Kalfas teaches of displaying an indicator in association with the line item to identify the line item as a body-less electronic mail message (Paragraphs 0037; 0038).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to display an indicator in association with the line item to identify the line item as a body-less electronic mail message. The motivation for the suggested combination is that Kalfas' teachings would improve the suggested system by providing indicator that would eliminate the need to open a message.

27. As per claim 41, Malik teaches the method of claim 1, further comprising:

receiving, by the first user, synchronous communications from the second user (Paragraph 0094. IM chat messages between user and contact.); receiving, from the first user, a command to initiate asynchronous communications with the second user (Paragraph 0070. Compose new email to a contact.); converting, in response to the command to initiate asynchronous communications, the received synchronous communications into a second body-less electronic mail message; and transmitting the second body-less electronic mail message to the second user over the network (It is inherent that a user may copy and paste the contents of an IM message into the subject of the email message.).

28. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik, Resnick, and Kalfas, in view of Whittle et al. US Publication #2005/0050462 (Whittle hereinafter).

29. As per claim 4, Malik, Resnick, and Kalfas taught the method of claim 1. Malik, Resnick, and Kalfas further teach the method of claim 1, further comprising receiving the body-less electronic mail

message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view (fig. 9). Malik does not specifically teach of displaying on the display screen an entire contents of the subject line when a cursor is positioned over a subject column of the line item.

30. Whittle teaches of positioning a pointer over a text to cause the entire partition of the text to be displayed (abstract; paragraph 0023).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to implement a system wherein positioning a pointer over a text, such as text of a subject line, causes the entire portion of the text to be displayed. The motivation for the suggested combination is that Whittle's teachings would improve the suggested system by allowing users to efficiently view content and optimize the use of space on a window (Paragraph 0020; 0022).

32. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik, Resnick, and Kalfas, in view of Yong, US Patent #6,963,904 (Yong hereinafter).

33. As per claim 35, Malik does not specifically teach the method of claim 34, further comprising automatically placing a delineator between a text message presently in the subject line of the body-less electronic mail message when the first user receives the body-less electronic mail message and a text message subsequently added to the subject line after the first user chooses to reply to or forward the received body-less electronic mail message.

34. Yong teaches of automatically placing a delineator between a text message presently in the subject line of an electronic mail message when the first user receives the electronic mail message and a text message subsequently added to the subject line after the first user chooses to reply to or forward the received electronic mail message (col. 1, lines 40-56. Insert "RE:").

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to automatically place a delineator between a text message presently in the subject line as taught by Yong of the body-less electronic mail message as taught by suggested system when the first user receives the body-less electronic mail message and a text message subsequently added to the subject line after the first user chooses to reply to or forward the received body-less electronic mail message. The motivation for the suggested combination is that Yong's teachings would improve efficiency by allowing a recipient to know whether the electronic mail is regarding a previously discussed topic and allowing separation of content.

36. As per claim 36, Malik does not specifically teach the method of claim 35, wherein the delineator includes a carriage return so that the text message subsequently added to the subject line appears on a new line within the subject line.

37. Resnick teaches that a carriage return can be placed in a message including the subject line (section 2.2.3)

38. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to include a carriage return to the subject line as taught by Resnick so that additional text may appear on a new line. The motivation for the suggested combination is that Resnick's teachings would improve the suggested system by allowing additional input of data into a header.

39. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik, Resnick, and Kalfas, in view of Zhang et al. US Patent #6,016,478 (Zhang hereinafter).

40. As per claim 37, Malik does not specifically teach the method of claim 1, further comprising automatically signing each text message in the subject line with an identity of an author of that text message.

41. Zhang teaches the concept of using an email program to incorporate a signature in the subject line of a message that identifies the sender of the message (col. 7, lines 59-65).

42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to automatic sign each text message in the subject line with an identity of an author of the text message. The motivation for the suggested combination is that Zhang's would improve the suggested system by allowing rapid identification of messages.

43. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik, Resnick, and Kalfas, in view of Eason, US Publication #2005/0039028 (Eason hereinafter).

44. As per claim 39, Malik does not specifically teach the method of claim 1, further comprising preventing the first user from deleting content from the subject line of the received body-less electronic mail message.

45. Eason teaches of preventing a recipient from deleting content from the subject line of an electronic mail (Paragraphs 0045; 0046. Write protect the electronic mail).

46. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to combine the teachings to prevent a user from deleting content from the subject line in a received electronic mail as taught by Eason such as in a body-less electronic mail as taught by the suggested system. The motivation for the suggested combination is that Eason's teachings would improve the security of the suggested system by preventing altering of the received email.

Conclusion

47. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./
Examiner, Art Unit 2154

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2154